

### Remarks

The office action of November 26, 2008 has been carefully reviewed. In response to this office action, claim 1 has been amended. Claims 1-23 are currently pending and presented for review. Favorable reconsideration and allowance are respectfully requested in light of the remarks which follow.

### Declaration

The Examiner has concluded that Applicant's original declaration, filed March 15, 2007, along with Applicant's supplemental declaration and the declaration of Applicant's Attorney, filed February 12, 2008, were ineffective to overcome Epler et al. (U.S. Patent Application Publication 2003/0187615) as prior art. Specifically, the Examiner has concluded that the evidence submitted to establish Applicant's conception and diligence in reducing the invention to practice from a date before the priority date of Epler et al. was insufficient to establish diligence for the time periods of 4/19/2002-7/30/2002. Applicant, therefore, has enclosed further evidence of Applicant's conception and diligence, including a second supplemental §1.131 declaration. The supplemental §1.131 declaration of Inventor Barthell is further supported by Appendix A.

Although the Examiner cites various cases allegedly supporting the assertion that each and every day of a critical period in question must be accounted for, **"diligence must be judged on the basis of the particular facts in each case."** MPEP § 715.07(a). Specifically, the Examiner cites *In re Mulder* as demonstrating that "a 2-day period lacking activity has been held to be fatal" as a foundation for the assertion that diligence must be accounted for each and every day.

Applicant respectfully submits that *Mulder* is limited to exceptions not applicable here. In *Mulder*, the applicant provided proof of a draft patent application being complete in the United States on July 15, 1974. The applicant then filed a Dutch patent application on October 9, 1974. A U.S. patent application was subsequently filed in August 1975, claiming priority to the Dutch application. The applicants later attempted to overcome a prior art reference dated October 7, 1974 by showing that the draft application was prepared in July. Although *Mulder* has been cited in support of the proposition that "a 2-day period lacking activity [can] been held to be fatal," "[f]ocussing on the shortness of the gap is misleading." *In re Mulder*, 716 F.2d at 1545. The reason the court refused to allow the priority claim was not because of a two day lack of diligence, but rather because "[d]uring the period between the time the draft application was received in [the United States] and the time the application was filed in the U.S. PTO, the record shows no activity of any kind in this country." *In re*

*Mulder*, 716 F.2d at 1545 (emphasis added). Thus, it is because **there was no activity of any kind for over a year** that the court ruled that there was no diligence in reducing the invention to practice.

Applicant submits that the proper inquiry is “whether, on all of the evidence, there was **reasonably continuing activity** to reduce the invention to practice. There is no rule requiring a specific kind of activity in determining whether the applicant was reasonably diligent in proceeding toward an actual or constructive reduction to practice.” *Brown v. Barbacid*, 436 F.3d 1376, 1380 (Fed. Cir. 2006). The case law clearly demonstrates that diligence is demonstrated by the facts of a specific case and that, what might be considered non-diligent for one applicant under one set of circumstances, may be diligence for another applicant under another set of circumstances. The evidence provided herewith in conjunction with the information previously provided is believed to satisfy Applicant’s burden with respect to establishing priority before the effective date of Epler et al. through conception before the priority date of Epler et al. and reasonable diligence to Applicant’s filing date.

Applicant submits that there was reasonable continuing activity by the inventor to reduce the invention to practice during the time period identified by the Examiner (4/19/2002-7/30/2002). During this time period, inventor Dr. Barthell collaborated with other physicians to conduct a survey to collect feedback regarding the invention (see Barthell Declaration, ¶10) and continued to refine the invention (see Barthell Declaration, ¶11). Summaries of a sampling of emails during this time period demonstrate the ongoing solicitation and compilation of feedback along with an ongoing refinement of the invention. Barthell Declaration, ¶11. Although each and every day is not explicitly referred, it is only reasonable to allow those who are being queried a reasonable time to formulate appropriate responses and/or conduct the activities requested of them.

During this time period, Dr. Barthell was also employed as a full-time emergency care clinician whose other demands left him an average of no more than four to six hours a week to devote to the Frontlines project. Barthell Declaration, ¶8. Despite the obligations of full-time employment, applicant never let more than a few days pass without working on refining the invention except when he was waiting on results from others. Barthell Declaration, ¶15. The Examiner is required to take these limitations on Dr. Barthell’s availability into account because it is well-established that an inventor need not abandon his livelihood to be reasonably diligent. *Courson v. O’Connor*, 227 F. 890, 894 (7th Cir. 1915). The *Courson* decision is highly relevant to the facts of the present case. The inventor in *Courson*, like Dr. Barthell, was employed full time in a capacity

unrelated to his invention. His primary employment placed heavy demands on his time that excused periods of inactivity that greatly exceeded Dr. Barthell's. The Court of Appeals stated:

If Courson was to retain his important and highly responsible position with the railroad, he was necessarily compelled to make the perfecting of his invention and the preparation for his patent subordinate to his other pressing daily activities. But we cannot agree with the learned trial judge that even if, under the foregoing facts, the conclusion were justified that the invention received only such attention as Courson was able to give it after the full discharge of his immediate obligations to his employer, a lack of reasonable diligence is to be charged against him.

*Id.*

The facts asserted in this additional declaration further evidence Dr. Barthell's reasonable diligent effort in reducing the subject matter of this application to practice.

As also stated in MPEP §2138.06, "The diligence of attorney in preparing and filing patent application inures to the benefit of the inventor." The section further explains that "Reasonable diligence is all that is required of the attorney [and] reasonable diligence is established if attorney worked reasonably hard on the application during the continuous critical period." MPEP §2138.06 further allows that "If the attorney has a reasonable backlog of unrelated cases which he takes up in chronological order and carries out expeditiously, that is sufficient [and that] work on a related case(s) that contributed substantially to the ultimate preparation of an application can be credited as diligence."

Applicant previously enclosed a §1.132 Declaration executed by Attorney Timothy E. Newholm. The statements set forth in the §1.132 declaration are further evidence Attorney Newholm's diligent efforts in assessing the patentability of the conceived subject matter and includes evidence related to the diligent efforts of Attorney Newholm in the preparation of the underlying patent application. The §1.132 declaration demonstrates diligence for at least the time period of 7/16/2002-7/30/2002. Collectively, the documents previously provided along with the additional evidence provided herein demonstrate the reasonable and diligent efforts of the applicant in reducing the invention to practice over the time period specified by the Examiner.

#### **Claim Rejections – 35 U.S.C. § 101**

The Examiner has asserted that claim 1 is unpatentable under 35 U.S.C. § 101 because the claimed invention is directed to non-statutory subject matter. Applicant respectfully submits that

claim 1, as amended, is directed to statutory subject matter and requests that this rejection be withdrawn.

**.Claim Rejections – 35 U.S.C. § 102**


The Examiner has asserted that claims 1-23 are anticipated under 35 U.S.C. § 102(e) by Epler et al., U.S. Publication No. 2003/0187615.

The materials provided herein, in conjunction with the materials previously provided, clearly evidence Applicant's conception of the claimed invention prior to the priority date of Epler et al. and further evidence the Inventor's reasonable diligence in reducing to practice the claimed invention. Accordingly, Applicant believes that Epler et al. has been disqualified as prior art with respect to the above-captioned application. Therefore, the rejection premised on Epler et al. must be withdrawn.

**Conclusions**

In light of these remarks and amendments, it is believed that claims 1-23 are now in condition for allowance and allowance is respectfully requested. This Amendment is being filed along with a petition for revival of the application and the appropriate petition fee. Although no additional fees are believed payable, the Office is hereby authorized to charge any additional fees that may be deemed due, or credit any overpayment, to Deposit Account No. 50-1170. The Examiner is encouraged to contact the undersigned if minor amendments are needed in the figures, specification, or claims to bring this case into allowance.

Respectfully submitted,



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